



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/543,174	07/22/2005	Gerard Remkes	2565/132	7919
26646 7590 07/13/2010 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
BASS, DIRK R				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
07/13/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/543,174

Applicant(s)

REMKE ET AL.

Examiner

DIRK BASS

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 24, 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-40 is/are pending in the application.
- 4a) Of the above claim(s) 16-22, 31-34, 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-30, 35, 39-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's response filed May 24, 2010 is acknowledged. Claims 23-28 and 39 are amended and claims 16-22, 31-34, 36-38 are withdrawn from consideration. Claims 23-30, 31-34, and 37-38 are further considered on the merits.

Response to Amendment

In response to applicant's amendment, the examiner maintains the grounds of rejection set forth in the office action dated February 23, 2010.

Election/Restrictions

Applicant's election with traverse of group II in the reply filed on May 24, 2010 is acknowledged. The traversal is on the ground(s) that there is no burden to search for both the apparatus and method claims. This is not found persuasive because the apparatus and method claims have been found to be independent and/or distinct from each other. Furthermore, the examiner has found that the apparatus and method are classified in different classes, thereby establishing a burden for the examiner to examine both groups.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. **Claim 24** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 24 recites the limitation "control and calculating unit". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 23-30, 35, 39-40** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Connell et al., US 5744027 (Connell).
3. Regarding claims 23 and 26, Connell discloses an apparatus for supplying a dialyser of a dialysis unit with a dialysing fluid (abstract, fig. 1A-B) comprising:
 - a. At least one receiving unit for dialysing fluid concentrate (REF 116, fig. 1B);
 - b. Means for providing water for diluting the dialysing fluid concentrate (REF 82, fig. 1A);
 - c. Means for mixing the dialysing fluid concentrate and the water (REF 120, fig. 1B);
 - d. A means for supplying the dialysing fluid to the dialyser (Claim 7) and
 - e. A means for setting a dialysing fluid flow rate (col. 15, l. 65-col. 16, l. 15, col. 17, l. 33-44, and REF 500, fig. 7).
4. Regarding the limitations reciting *configured to* language, the examiner considers these to be statements with regard to the intended use and are not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02). The examiner reminds applicant that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim (MPEP 2114).
5. Regarding claim 24, the limitations "determines the dialysis fluid flow rate..." and "configured to set..." are deemed to be statements with regard to the intended use and are not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

6. Regarding claim 25, Connell discloses an apparatus further comprising a means for testing the apparatus over a pre set time interval and a means for determining a volume of the at least one dialysing fluid concentrate in the at least one receiving unit (col. 17, l. 22-47 and REF 500, fig. 7).
7. Regarding claim 27, Connell discloses means for discharging the pre-set residual volume of the dialysing fluid concentrate to waste via a waste discharge outlet (REF 66, 166, and 198, fig. 1A-B). The "wherein..." limitations are considered to be statements with regard to the intended use and are not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02).
8. Regarding claim 28, Connell discloses means for mixing the pre-set residual volume of the dialysing fluid concentrate with water (REF 120, fig. 1B). The "wherein..." limitation is considered to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02).
9. Claim 29 is considered to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02).
10. Regarding claim 30, Connell discloses means for inputting data (fig. 7-11).
11. Regarding claim 35, Connell discloses an apparatus comprising two receiving units (REF 116, 112, fig. 1B).
12. Regarding claim 39, Connell discloses means for discharging the pre-set residual volume of the dialysing fluid concentrate to waste via a waste discharge outlet (REF 66, 166, and 198, fig. 1A-B). The "wherein..." limitations are considered to be statements with regard to the intended use and are not further limiting in so far as the structure of

the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02).

13. Claim 40 is considered to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02).

Response to Arguments

14. Applicant's arguments filed May 24, 2010 have been fully considered but they are not persuasive.

15. Applicant argues that the apparatus disclosed by Connell does not show features which are presently claimed. In response, the examiner directs applicant's attention to the rejections set forth above and the relevant passages of the prior art.

16. The examiner reminds applicant that statements with regard to the intended use are not further limiting in so far as the *structure* of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIRK BASS whose telephone number is (571) 270-7370. The examiner can normally be reached on Mon - Fri (9am-4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571) 272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/
Primary Examiner, Art Unit 1797

/DRB/
Dirk R. Bass